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EXAMINER

LU, KUEN S

ART UNIT

PAPER NUMBER

2167

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/023,990

Applicant(s)

SEIBEL ET AL.

Examiner

Kuen S. Lu

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendments*

1. The Action is responsive to the Applicant's Amendments, filed on June 2, 2005.
2. The Applicant's Amendments, filed on June 2, 2005, has been fully considered by the Examiner, please see discussion in the section ***Response to Declaration*** and ***Response to Arguments***, following the Office Action for non-Final Rejection shown next. Please note the Examiner maintains the same position for claims rejection as set forth in the Office Action for Final Rejection of March 2, 2005.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3 and 11-13 are rejected under 35 U.S.C. 102(e) as anticipated by Chung (U.S. Publication 2004/0046021).

As per Claims 1 and 11, Chung teaches the following:

"storing a database of voter records, each voter record comprising at least one voter characteristic, based on said at least one voter characteristic, generating a paper ballot" at Page1, [0015] and 17, [0144] where paper ballots are utilized and voter eligibility is

stored in a database, and at Page 19, [0155], lines 15-22 where the voting options is stored in a database for being utilized to generate the ballots.

As per Claims 2 and 12, Chung teaches “based on said at least one voter characteristic, determining a set of positions and issues for which a voter is eligible to vote” at Page 1, [0015] where paper ballots are utilized, Page 19, [0155], lines 10-22 where verified voter identifier is utilized by the ballot generating logic to produce for the voter the particular combination of general ballot voting screens and criteria-specific ballot voting screens for that particular voter in the particular election, and “generating a ballot comprising said set of positions and issues” at Page 19, [0155], lines 15-22 where voting options relating to each office and/or question is stored in database and utilized by the ballot generation logic in generating the ballots.

As per Claims 3 and 13, Chung teaches “marketing the voter record associated with said generated ballot as voted” at Page 19, [0155], lines 10-22 where verified voter identifier is utilized by the ballot generating logic to produce for the voter the particular combination of general ballot voting screens and criteria-specific ballot voting screens for that particular voter in the particular election.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 24-43 are rejected under 35 U.S.C. 102(b) as anticipated by McClure et al. (U.S. Patent 6,250,548, hereafter "McClure").

As per Claims 24 and 35, McClure teaches the following:

"a scanner adapted to generate a computer readable visual representation of a voted paper ballot" at col. 1, lines 18-44 where paper ballots are utilized, col. 43, lines 37-59 by scanning the voter and the voter is assigned the specific ballot styles, and at Figs. 25-26 where absentee ballot was scanned, targets located, position origin set, bar code decoded, ballot verified, ballot image constructed and image stored;

"a processor adapted to generate vote data based on said visual representation" at col. 42, lines 59-65 by showing voting tablet is ready for the voter to make his/her selections; and

"visual representation being associated with said vote data and said voted ballot" at col. 42, line 65 – col. 43, line 16 where voting styles according to each voter is displayed for his/her selection and at Figs. 25-26 and col. 43, lines 14-16 and 36-46, by generating ballot image.

As per Claim 25 and 36, McClure teaches "a display device adapted to display at least one said visual representation and said vote data associated therewith" at col. 42, lines 65-67 where voting tablet displays governor selection is the starting of the ballot selection and cast, and at col. 42, lines 60-67 by showing the voting steps in the voting

booth and voting tablet illuminating and displaying message for starting the voting and casting process.

As per Claims 26 and 37, McClure teaches “mark said voted ballot with a unique ballot identification” at col. 43, lines 24-31 by showing cast ballot and voter identification are linked together before ballot is selected and cast.

As per Claims 27 and 38, McClure teaches “associate said unique ballot identification with said vote data and said visual representation of said voted ballot” at col. 42, line 65 – col. 43, line 16 where voting styles according to each voter is displayed for his/her selection.

As per Claims 28 and 39, McClure teaches “a storage device for storing said vote data and said visual representation” at col. 43, lines 32-35 and col. 44, lines 1-5 where the readable cast ballot is moved into the primary storage location at the voting site and later transmitted to a central computer to store, and at col. 9, lines 5-6 where commercial database for storing cast ballot includes relation databases.

As per Claims 29 and 40, McClure teaches “said storage device comprises a database” at col. 43, lines 32-35 and col. 44, lines 1-5 where the readable cast ballot is moved into the primary storage location at the voting site and later transmitted to a

central computer to store, and at col. 9, lines 5-6 where commercial database for storing cast ballot includes relation databases.

As per Claims 30 and 41, McClure teaches "wherein said storage device comprises a relational database" at col. 43, lines 32-35 and col. 44, lines 1-5 where the readable cast ballot is moved into the primary storage location at the voting site and later transmitted to a central computer to store, and at col. 9, lines 5-6 where commercial database for storing cast ballot includes relation databases.

As per Claims 31 and 42, McClure teaches "a display device, wherein said processor is adapted to retrieve said visual representations and said associated vote data, and to display said visual representation and said vote data on said display device" at col. 42, lines 65-67 where voting tablet displays governor selection is the starting of the ballot selection/cast, and at col. 42, lines 60-67 by showing the voting steps in the voting booth and voting tablet illuminating and displaying message for starting the voting/casting process.

As per Claim 32, McClure teaches "retrieving at least one of a plurality of records from said storage device, each record comprising vote data and a visual representation of a voted ballot" at col. 44, lines 15-21 where voting data can be traced to the voting tablet level from the backup copy of the voted ballots.

As per Claim 33, McClure teaches "processor is adapted to modify said vote data" at

col. 43, lines 25-30 where voter can move his/her selections before finally casting by pressing the ballot cast button.

As per Claims 34 and 43 McClure teaches "modify said vote data based on a review of the voted ballot associated with said unique ballot identification in said vote data" col. 43, lines 25-30 where voter can move his/her selections before finally casting by pressing the ballot cast button.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 4-7, 10 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung (U.S. Publication 2004/0046021), as applied to Claims 1-3 and 11-13 above, and in view of McClure et al. (U.S. Patent 6,250,548, hereafter "McClure").

As per Claims 4 and 14, Chung teaches generating particular ballot to particular voter based on the particular voter's eligibility as described earlier in Item 2.



Chung does not specifically teach generating ballot into specific two portions and mailing the portions with return envelope to voters, although Chung teaches paper ballots at Page 1, [0015].

However, McClure teaches “generating said paper ballot comprising a voter associated portion and an anonymous portion” at col. 31, lines 51-52 where ballot is mailed to voter itself suggests voter associated portion is generated and printed for delivering the ballot by mail, and “mailing said ballot to a voter identified in said voter associated portion, together with an anonymous envelope and a return envelope” at Fig. 26, elements 180-184 and col. 31, lines 51-67 showing the absentee ballot consisting of top and bottom sheets is mailed to the voter where the top sheet and the mailing information of the voter is the voter associated portion, while the bottom sheet is the anonymous portion to be mailed back by the voter by using the return envelope as enclosed.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine McClure's reference with Chung's by printing voter information and his/her particular options combined but anonymous ballot separately or detachably such that the ballot could have been sent back without showing the voter's identification as commonly practiced by public opinion poll where pollster is only interested in “public” opinion by the some categories of people polled.

As per Claims 5 and 17, McClure further teaches “generated ballot comprises means for separating said voter associated portion and said anonymous portion” at Fig. 26,

elements 180-184 and col. 31, lines 51-60 where the top sheet is removed, by using perforated edges, from the bottom sheet which is the ballot to be mailed back to the headquarter.

As per Claim 6, McClure further teaches “anonymous portion is adapted to be inserted into said anonymous envelope” at Fig. 26 and col. 31, lines 51-60 by showing absentee ballot is sent by the mail and at col. 31, lines 40-45 where all portions and return envelope fit in an outer envelope tied together by perorated edges.

As per Claim 7, McClure further teaches “anonymous envelope is adapted to be enclosed in said return envelope” at Fig. 26 and col. 31, lines 51-60 by showing absentee ballot is sent by the mail and at col. 31, lines 40-45 where all portions, including the ballot, and the return envelope fit in an outer envelope tied together by perorated edges.

As per Claim 10, McClure further teaches “return envelope is addressed to a vote receiving location” at col. 31, Claim 31-60 where the return envelope is to be returned to the headquarter.

As per claim 15, McClure further teaches “a return envelope and an anonymous envelope” at col. 31, lines 51-52 where ballot is mailed to voter itself suggests voter associated portion is generated and printed for delivering the ballot by mail, and “mailing

said ballot to a voter identified in said voter associated portion, together with an anonymous envelope and a return envelope” at Fig. 26, elements 180-184 and col. 31, lines 51-67 showing the absentee ballot consisting of top and bottom sheets is mailed to the voter where the top sheet and the mailing information of the voter is the voter associated portion, while the bottom sheet is the anonymous portion to be mailed back by the voter by using the return envelope as enclosed.

As per Claim 16, McClure further teaches “anonymous portion of said ballot is adapted to be inserted into said anonymous envelope” at Fig. 26 and col. 31, lines 51-60 by showing absentee ballot is sent by the mail and at col. 31, lines 40-45 where all portions and return envelope fit in an outer envelope tied together by perorated edges, and “said anonymous envelope is adapted to be inserted into said return envelope” at Fig. 26 and col. 31, lines 51-60 by showing absentee ballot is sent by the mail and at col. 31, lines 40-45 where all portions, including the ballot, and the return envelope fit in an outer envelope tied together by perorated edges.

9. Claims 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung (U.S. Publication 2004/0046021) and in view of McClure et al. (U.S. Patent 6,250,548, hereafter “McClure”).

As per Claim 18, Chung teaches “marketing each of a plurality of voted paper ballots with a unique ballot identification” at Page 1, [0015] where paper ballots are utilized,

Page 19, [0155], lines 10-22 where verified voter identifier is utilized by the ballot generating logic to produce for the voter the particular combination of general ballot voting screens and criteria-specific ballot voting screens for that particular voter in the particular election.

Chung does not specifically teach “scanning said plurality of voted ballots and generating computer readable visual representations of each of said ballots”.

However, McClure teaches voter eligibility is validated by scanning the voter and the voter is assigned the specific ballot styles at col. 43, lines 37-59.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine McClure's reference with Chung's by performing voter scanning, validating voter and creating voter styles accordingly in one series of combined operations because by doing so a proper combination of voting styles for each voter could have been created accordingly for proving a correct eligibility for voter immediately before he/she stepping in a voting booth to cast his/her ballot.

McClure further teaches the following:

“generating vote data associated with each of said plurality of voted ballots based on said visual representations” at col. 42, lines 59-65 by showing voting tablet is ready for the voter to make his/her selections; and

“associating each said visual representation and corresponding vote data with said voted ballot based on said unique ballot identification” at col. 42, line 65 – col. 43, line 16 where voting styles according to each voter is displayed for his/her selection.

As per Claim 19, McClure further teaches "vote data comprises said unique ballot identification" at col. 43, lines 24-31 by showing cast ballot and voter identification are linked together before ballot is selected and cast.

As per Claim 20, McClure further teaches "storing said computer readable visual representation and said vote data in a database" at col. 43, lines 32-35 and col. 44, lines 1-5 where the readable cast ballot is moved into the primary storage location at the voting site and later transmitted to a central computer to store.

As per Claim 21, McClure further teaches "storing said computer readable visual representation and said vote data in a relational database" at col. 9, lines 5-6 where commercial database for storing cast ballot includes relation databases.

As per Claim 22, McClure further teaches the following:  
"retrieving at least one of said computer readable visual representations" at col. 42, lines 65-67 where voting tablet displays governor selection is the starting of the ballot selection/cast;  
"displaying said visual representation and said vote data associated therewith on a display device" at col. 42, lines 60-67 by showing the voting steps in the voting booth and voting tablet illuminating and displaying message for starting the voting/casting process and "modifying said vote data associated therewith" at col. 43, lines 25-30

where voter can move his/her selections before finally casting by pressing the ballot cast button.

As per Claim 23, McClure further teaches the following:

“retrieving at least one of said computer readable visual representations” at col. 42, lines 65-67 where voting tablet displays governor selection is the starting of the ballot selection/cast;

“displaying said visual representation and said vote data associated therewith on a display device” at col. 42, lines 60-67 by showing the voting steps in the voting booth and voting tablet illuminating and displaying message for starting the voting/casting process;

“retrieving the voted ballot associated with said visual representation based on said unique ballot identification” at col. 43, lines 24-31 by showing cast ballot and voter identification are linked together before ballot is selected and cast; and

“modifying said vote data associated with said voted ballot and said visual representation” at col. 43, lines 25-30 where voter can move his/her selections before finally casting by pressing the ballot cast button.

**10.** Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung (U.S. Publication 2004/0046021) and in view of McClure et al. (U.S. Patent 6,250,548, hereafter “McClure”), as applied to Claim 4 above, and further in view of Jenkins (U.S. Patent 4,776,510).

As per Claim 8, the combined McClure-Chung reference teaches generating ballot with separable portions and sending the portions with return envelope to the voters.

The combined reference does not specifically teach enclosing envelope and some additional material into another envelope.

However, Jenkins teaches "voter associated portion is adapted to be enclosed in said return envelope out side of said anonymous envelope, said anonymous portion is adapted to be enclosed in said anonymous envelope, and said anonymous envelope is adapted to be enclosed in said return envelope" at Fig. 2 and "SUMMARY OF THE INVENTION" by teaching a method for incorporating return envelope and material in a two-part mailer.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Jenkins and McClure's references with Chung's by printing anonymous ballot and voter associated information, sending and enclosing this mailing materials with return envelope logically such that the package could have been received and handled logically and effectively by the receiving voters in a way as regularly practiced by pollsters for polling public opinions.

As per Claim 9, McClure teaches "receiving said return envelope, separating said anonymous envelope from said voter associated portion, and marking the voter record associated with the voter identified in said voter associated portion as voted" at col. 31, lines 51-60 by showing instructions for performing steps of receiving ballot package,

separating mailing materials, marking the ballot, placing voted ballot into return envelope and sending back to the headquarter.

***Response to Declaration***

11. The declaration filed on June 2, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Chung reference (U.S. Patent Application Publication, 2004/0046021, hereafter "Chung").

The evidence submitted by applicants consists of Declaration under 37 C.F.R. § 1.131 and Exhibits A-B for declaring "The invention was completed in the United States by making and successfully testing an automated ... in the subject system, before November 3, 2000". With regard to making and successfully testing an automated system for the subject system before November 3, 2000, Applicant must show evidence of facts showing conception occurs prior to the date of the reference but reduction to practice is afterward. See *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). The Applicant, however, has blacked out every column displaying a date in the Exhibits. For the reasons as discussed, the Applicant's declaration of "The invention was completed in the United States by making and successfully testing an automated ... in the subject system, before November 3, 2000" is not considered satisfactory evidence. Consequently, in this Office Action for Non-Final Rejection the 35 U.S.C. § 102 and 35 U.S.C. § 103 rejections to claims 1-43 is maintained on the same grounds as set forth in the Office Action for Final Rejection, dated March 2, 2005.

***Response to Arguments***



**12.** The Applicants' arguments filed on June 2, 2005 have been fully considered, for the Examiner's response, please see discussion below.

a). At Page 2-3, the Applicant argued that the McClure reference does not teach "generate a computer readable visual representation of a voted paper ballot".

As to the above argument, the Examiner respectfully further submitted that at Figs. 25-26, the McClure reference teaches absentee ballot was scanned, targets located, position origin set, bar code decoded, ballot verified, ballot image constructed and image stored. The Examiner interpreted the steps as a teaching of "generate a computer readable visual representation of a voted paper ballot".

a). At Page 2-3, the Applicant argued that the McClure reference does not teach "generate vote data based on said visual representation".

As to the above argument, the Examiner respectfully further submitted that at Figs. 25-26 and col. 43, lines 14-16 and 36-46, McClure reference teaches generating ballot image.

**13.** The prior art made of record

A. U.S. Publication 2004/0046021

B. U.S. Patent 6,250,548

C. U.S. Patent 4,776,510

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

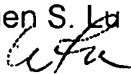
D. U.S. Patent 5,218,528

E. U.S. Patent 5,878,399

**Contact information**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S. Lu whose telephone number is (571) 272-4114. The examiner can normally be reached on Monday-Friday (8:30 am-5:30 pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for Page 13 published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).

Kuen S. Lu  
  
Patent Examiner

August 6, 2005

  
Mohammad Ali

Primary Examiner

August 6, 2005